

Atty. Docket No. 156.0001  
Appl. No. 09/310,965

**PATENT**

Applicant respectfully submits that the amendment of claim 15 addresses this rejection. Applicant respectfully requests that this indefiniteness rejection be withdrawn.

**35 U.S.C. §102(b) - Thomas, Jr.**

Claim 15 has been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Thomas, Jr. (U.S. Pat. No. 4,768,778). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found . . . in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of Calif.*, 2 USPQ.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ.2d 1913, 1920 (Fed. Cir. 199). In this regard, Applicant respectfully submits that the invention as claimed includes elements not expressly or inherently described in Thomas.

Claim 15 has recited and continues to recite that the "upper platform includes . . . a fist pad attached to said upper surface and extending above said upper surface . . ."

*first pad is a typo -- fist pad*  
The Examiner continues to assert that "fist pad" should be read as "first pad," which is contrary to how "fist pad" is defined and described in the specification in the paragraph bridging pages 8 and 9 as providing a cushion for a fist. Thomas discloses decorative material 84. Col. 6, lines 4-5. However, above the decorative material is a handle 26, which the user grabs and holds during use thus not coming in contact with the decorative material as illustrated in Figure 2, which does not show pressure being applied to decorative material 88. Thus, decorative material 88 should not be construed as a fist pad.

*intended use*

Furthermore, the recitation of a "fist pad" in claim 15 inherently eliminates the possibility of the inclusion of a handle for grabbing by the user above it. Thus, it is contrary to common sense to use Thomas teaching a handle 26 as the basis for a 35 U.S.C. §102 rejection.

For the above reasons, Applicant respectfully requests that this rejection be withdrawn.

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**35 U.S.C. §103 - Thomas, Jr.**

Claim 16 has been rejected under 35 U.S.C. §103(a) as allegedly anticipated by Thomas, Jr. This rejection is respectfully traversed. Applicant is troubled that a previously allowed claim is now being rejected.

Claim 16 recites a stopper that is capable of engaging the lower housing and the upper housing such that the two housings will not rotate relative to each other. The stopper is described, for example, in the bottom paragraph of page 9 of the specification and illustrated, for example, in Figure 3(a). The first bearing surface 110 and second annular lip 114 with a second bearing surface 116 of Thomas are incapable of providing resistance and stopping power to prevent the upper platform from rotating relative to the lower housing. See col. 7, lines 10-31, Fig. 9. In fact, the very names of these elements indicate these elements are present in Thomas for allowing the upper platform to rotate relative to the lower housing, which is contrary to the recited stopper in claim 16.

Applicant is unsure of what is being referred to in the last paragraph on page 3 of the Office Action to multiple "housing caps" as claim 16 recites a lower housing cap. Applicant submits that Office Action fails to state how Thomas teaches or suggests a lower housing cap given the reference to "housing caps" on two occasions in the last paragraph on page 3.

Furthermore, Thomas fails to teach the openings recited in claim 16 that are present in the wall extending down from the upper platform and the lower housing.

Accordingly, and without waiving any other arguments, Applicant respectfully submits that reconsideration and withdrawal of the present rejection is proper and such action is respectfully requested.

**35 U.S.C. §103(a) - Thomas combination**

Claims 1-3 and 21 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Thomas in view of Montgomery (U.S. Pat. No. 5,226,868) and Karstadt (U.S. Pat. No. D141,456). This rejection is respectfully traversed. Applicant respectfully submits that the Examiner indication during a telephone conversation On

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April 19, 2002 that claims 1-3 and 21 were allowable is the correct view, particularly in view of the reasons below.

The combination of the device taught by Montgomery with the device taught by Thomas is contrary to the disclosure of both patents. The Federal Circuit has confirmed that the Examiner needs to explain the motivation for combining multiple documents for the purposes of making a rejection under 35 U.S.C. §103(a). *In re Lee*, 277 F.3d 1338, 61 USPQ.2d 1430 (Fed. Cir. 2002) (cited for this proposition in *In re Mursan & Muresan*, 2002 U.S. App. LEXIS 7077 (Fed. Cir. April 3, 2002)).

When rejecting a claim for obviousness, the Examiner must articulate reasons for making the rejection. *Id.* at 1342. In particular, the Examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. *Id.* at 1343. Here the cited patents teach away and thus are unable to provide a motivation, teaching, or suggestion to combine them together for purposes of a rejection.

Montgomery lists as one of the objects of his device is to provide  
a power push-up device having a push-up board onto which are pivotally mounted two C-shaped handles having one end fitable into the board and the opposite end having an anti-skid cushion **to lock the position of the handles during push-up exercises**.

Col. 2, lines 32-37 (emphasis added). The objective to lock the handles in place is repeated in the next three stated objectives. See col. 2, lines 42, 50, 60. Thomas on the other hand which has its platforms 24 "rotating in opposite directions relative to one another" during a push-up exercise. Col. 4, lines 16-26.

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Thomas explicitly states that a device for accomplishing its objectives includes "an elongated handle mounted to the support, the elongated handle extending along a second axis generally parallel to the plane of rotation of the platform . . ." Col. 3, lines 11-13 (emphasis added). The plane of rotation is the horizontal plane, which would make the handle extending in the horizontal plane. This statement in Thomas clearly teaches away from a handle being angled relative to the plane of rotation. Consequently, these two patents teach devices that disclose devices functioning in

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different ways during an exercise and have explicit statements regarding the respective handles, thus they teach away from each other and are unable to provide a motivation to make this combination.

Applicant respectfully resubmits that the reliance upon Karstadt is improper because Karstadt is nonanalogous art, because the Office Action has failed to provide a rationale as to why the relevant standard is met. The standard for determining whether a piece of art is nonanalogous is 1) whether the art is within the field of the inventor's endeavor, and 2) if the art is not, then to determine whether the art is reasonably pertinent to the particular problem which the invention solves. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313 (Fed. Cir. 1986). Karstadt is a design patent for an iron, which is clearly outside the field of exercise devices and more particularly, push-up devices. The second prong is also not satisfied because an iron design is not reasonably pertinent to the problem solved by the invention as described in, for example, the background of the invention of this patent application. Additionally, common sense would not reasonably lead a person of ordinary skill into searching through the iron art to find a solution to a problem arising in connection to exercise devices. See *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ.2d 1443 (Fed. Cir. 1992). Therefore, claims 1-3 and 21 are patentable because Karstadt contrary to the Examiner's statements is nonanalogous art and is not within the knowledge of one of ordinary skill in the art. Furthermore, Karstadt offers no motivation, teaching or suggestion for making this combination.

Therefore, claim 1 is patentable over the alleged combination of Thomas, Montgomery, and Karstadt. Claims 2, 3, and 21 are also patentable because of their dependency from claim 1. In an attempt to further prosecution if the Examiner disagrees with the above, Applicant will offer these additional reasons for patentability in connection to claims 3 and 21.

Claim 3 is patentable because the Examiner has failed to state how the alleged combination teaches and suggests each of the elements in claim 3. The Office Action is completely silent the basis for rejecting claim 3.

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Claim 21 recites a method for using the device recited in claim 1. Based on the patents relied upon by the Examiner, it is quite clear that Montgomery teaches the placement of the pinkie by the short upright as illustrated in Figure 1, which contrary to the Examiner's statement provides the description for how the user would use the conglomeration proposed by the Examiner. Additionally, someone who is ironing typically places their pinkie adjacent to the rear of the iron, which would be adjacent to the upright having a wider gripping area in Figure 2 of Karstadt. After selective use of the patents (which is contrary to established precedent, see *In re Fine*, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988)), the Examiner provides that the wider gripping area would be adjacent the short upright, which provides a second statement out of three documents for placement of the user's pinkie. Thomas is silent as to location, because its handle is completely horizontal and parallel to the floor. As stated above, the placement of the user's pinkie is not to increase the difficulty but to address ergonomical concerns that are not addressed or discussed in any of the art relied upon by the Examiner. The Examiner provides no rationale as why one of ordinary skill in the art would change the placement of the pinkie given the teachings of Karstadt and Montgomery.

Therefore, Applicant, without waiving any other arguments, respectfully submits that reconsideration and withdrawal of the present rejection is proper and such action is respectfully requested.

**35 U.S.C. §102(b)/103(a) - Hovda**

Claims 6, 7 and 9 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. §103(a) as allegedly obvious over Hovda (U.S. Pat. No. 1,533,500). This rejection is respectfully traversed.

The Office Action fails to state a suggestion, motivation, or teaching for stating that nuts 21, screw bolt 19, and head (which is the head of screw bolt 19) 20 should be considered to be regulating components as recited in claim 6. Page 1, lines 77-83. These three elements in Hovda form the central pivotal members. The device disclosed in Hovda is for teaching the concepts of the conservation of angular momentum and/or energy of rotation. Page 1, lines 9-13, page 1, line 101 to page 2, line 27. The entire

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purpose of the device is to have the two discs 1 and 2 be able to freely rotate relative each other without having the amount of rotation restricted. Therefore, elements 19, 20, and 21 are disclosed for the purposes of holding the two discs together. This is confirmed by claim 1, which recites "a central pivotal member for securing said discs together." Page 2, lines 36-37 (also see claim 2). Therefore, Hovda is unable to anticipate claim 6 or, in the alternative, make claim 6 obvious in view of these clear statements within the four corners of the U.S. patent to Hovda. Claims 7 and 9 are likewise patentable over Hovda in view of their dependency from claim 6.

Additionally, the rejection of claim 7 based upon screw bolt 19 serving as a friction material is insufficient. Hovda discloses screw bolt 19 being attached to a plate 7, which is attached to disc 1, and plate 16 which does not directly attach to disc 2. Applicant is confused how screw bolt 19 then can be the "friction material that is variably set to provide a range of resistance levels" that is recited in claim 7. It is submitted that screw bolt 19 is not the friction material recited in claim 7.

*2.9.11 up  
Hovda*

Therefore, Applicant, without waiving any other arguments, respectfully submits that reconsideration and withdrawal of the present rejection is proper and such action is respectfully requested.

**35 U.S.C. §103(a) - Hovda/Titus**

Claim 8 has been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Hovda in view of Titus (U.S. Pat. No. 2,256,001). This rejection is respectfully traversed.

Claim 8 is submitted as being patentable over this combination in view of its dependency from claim 6, which is submitted above as being patentable. Additionally, Hovda teaches away from this combination since a stated objective is "to provide a device consisting of a revolvable disc mounted thereon for supporting the demonstrator, and so constructed that the base and the revolving disc may be used interchangeably, that is to say, the base may be used as a supporting disc, or vice versa." Page 1, lines 26-36. The Office Action fails to provide a rationale for ignoring a stated objective in Hovda that teaches away from attaching a footing such as that taught by Titus.

*No Support  
On 11/16/02  
can it be  
here?*

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Therefore, Applicant, without waiving any other arguments, respectfully submits that reconsideration and withdrawal of the present rejection is proper and such action is respectfully requested.

Applicant acknowledges the Examiner's allowance of claims 4, 10, 13, and 14.

In view of the above amendments and Remarks, it courteously is urged that all the claims are allowable and that the application now is in condition for allowance. If the Examiner believes that the prosecution could be advanced through a telephone conversation, then the Examiner is invited to telephone the undersigned. Favorable action in this regard earnestly is solicited.

Respectfully submitted,  
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September 16, 2002

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the claims:**

15. (Twice Amended) An exercise device comprising:
- a upper platform, said upper platform includes
    - a bottom surface,
    - an upper surface opposed to said bottom surface, and
    - a fist pad attached to said upper surface and extending above said upper surface,
  - a lower housing connected to said upper platform,
  - a lower housing cap resting on and aligned with said lower housing,
  - a bearing element resting on said lower housing cap and abutting said upper platform, said bearing element allows said upper platform to rotate relative to said lower housing, and
  - regulating components that control rotation between said lower housing and said upper platform.